

App. No. 10/089409  
Office Action Dated April 14, 2004  
Amd. Dated July 14, 2004

### **REMARKS**

Reconsideration is respectfully requested in view of the above amendments and following remarks. Please note the initial PCT/JP00/07796 application was filed with original claims 1-17. Claims 15-17 were canceled in the Amendment under PCT Article 19 (replacement page 31). In addition claims 1, 2, 3, 4 and 11 were amended and claim 7 was canceled in the Amendment under PCT Article 34 (replacement pages 29, 30 and 30/1). Translations of the above noted documents were submitted at the time of filing. For the Examiner's reference, a listing of pending claims starts at page 4 of this paper. Claims 1-6 and 8-14 are pending.

The title has been amended to read "MAGNETO-OPTICAL DISK WITH PROTECTIVE LAYER, AND OPTICAL DISK DEVICE".

Proposed drawing corrections and replacement sheets are attached. Figs. 3A and 3B have amended to include --PRIOR ART--.

### **Claim rejections - 35 U.S.C. § 102**

Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Applicants' Prior Art (Figs. 3A and 3B). This rejection is rendered moot, as claim 12 depends from any of claims 1 to 4, which were not included in this rejection. Applicants do not concede the correctness of the rejection. Withdrawal of the rejection is respectfully requested.

Claims 1, 3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagataki et al. (US 5,527,479). Applicants respectfully traverse this rejection.

Independent claim 1 is directed to a read-only optical disk comprising a pit information surface. A read-only optical disk has a pit information surface, as recited in claim 1, in which

music and video information have been recorded and neither can be erased nor rewritten by the user. Nagataki relates to a rewritable disk and does not include a read-only optical disk. Thus, claim 1 is not anticipated by Nagataki. Withdrawal of the rejection is respectfully requested.

Independent claim 3 recites a partially recorded optical including a layer, divided into a pit information surface region and a magneto-optical recoding surface region. A partially recorded optical disk is well known as a partial ROM. The partial ROM has a configuration including on one disk a read-only region (corresponding to "a pit information surface region" as recited in claim 3) in which music and video information have been recorded and neither can be erased nor rewritten by the user and a recordable region (corresponding to "a megneto-optical recording surface region" in claim 3) in which music information and video information freely can be recorded by the user (page 21, line 10). Nagataki relates to a rewritable disk and does not include a partially recorded optical disk. Thus, claim 3 in not anticipated by Nagataki. Withdrawal of the rejection is respectfully requested.

Claim 5 depends from any of claims 1 to 4, for the reasons discussed above for claims 1 and 3 and in view of claims 2 and 4 not being included in this rejection, withdrawal of the rejection is respectfully requested.

**Claim rejections - 35 U.S.C. § 103**

Claims 2, 4, 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagataki et al. (US 5,527,479). Applicants respectfully traverse this rejection.

Independent claim 2 is directed to a read-only optical disk. Nagataki fails to render obvious the features of claim 2 for the same reasons presented above for claim 1.

Moreover, claim 2 recites the configuration in which the printing layer is provided between the pit information surface and the protective layer. As indicated by the Examiner, it is known to use a printing layer for labeling an optical disk. However, according to the known technique, a printing layer always is provided as an outermost surface layer. In contrast to this, in the configuration recited in claim 2, the protective layer is provided on the printing layer. As a result of this, while the printing layer is included, a floating-type magnetic head or a sliding-type magnetic head can be applied on the face on a side from which the printing layer can be seen. Thus, claim 2 is not obvious. Withdrawal of the rejection is respectfully requested.

Independent claim 4 is directed to a partially recorded optical disk including a layer, divided into a pit information surface region and a magneto-optical recording surface region. Therefore, Nagataki fails to render obvious the features of claim 4 for the same reasons presented above for claim 3.

Moreover, claim 4 recites the configuration in which the printing layer is provided between the protective layer and the layer divided into the pit information surface region and the magneto-optical recording surface region. That is, as in claim 2, the protective layer is provided on the printing layer. Thus, Nagataki fails to render obvious the features of claim 4 for the same reasons presented above for claim 2. Withdrawal of the rejection is respectfully requested.

Claims 6, 9 and 10 depend either directly or indirectly from any of claims 1 to 4, for the reasons discussed above for claims 2 and 4 and in view of claims 1 and 3 not being included in this rejection, withdrawal of the rejection is respectfully requested.

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Claim 7 was canceled under PCT Article 34, therefore, should not be included in this rejection. Withdrawal of the rejection is respectfully requested.

Claim 8 depends from claim 1 or 2, for the reasons discussed above for claim 2 and in view of claim 1 not being included in this rejection, withdrawal of the rejection is respectfully requested.

Independent claim 11 recites the configuration in which the printing layer is provided between the magneto-optical recording surface and the protective layer. That is, as in claims 2 and 4, the protective layer is provided on the printing layer. Thus, Nagataki fails to render obvious the features of claim 11 for the same reasons presented above for claims 2 and 4. Withdrawal of the rejection is respectfully requested.

In view of the above, favorable reconsideration in the form of a notice of allowance is requested. Any questions or concerns regarding this communication can be directed to the undersigned attorney, Douglas P. Mueller, Reg. No. 30,300, at (612)371.5237.

Respectfully submitted,

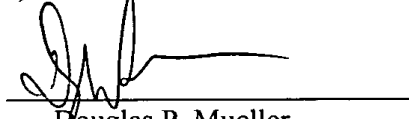
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Dated: July 14, 2004

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